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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WANG, SHENGJUN	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MIREILLE MAUBRU, BERNARD BEAUQUEY,
VERONIQUE DOUIN, and SANDRINE DECOSTER

Appeal 2007-3896
Application 09/759,530
Technology Center 1600

Decided: March 25, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a conditioning shampoo, which the Examiner has rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm but designate the affirmance a new ground of rejection.

BACKGROUND

The Specification discloses “cosmetic compositions with improved properties, intended both for cleaning and conditioning keratin materials such as the hair, and comprising, in a cosmetically acceptable aqueous vehicle, a washing base and at least one specific amphoteric starch” (Spec. 1: 1-4). The compositions are said to “give the hair, after rinsing, a noteworthy treating effect which is manifested, for example, by the provision of lightness, hold and suppleness” (*id.* at 2: 17-19).

“The washing base comprises at least one surfactant having washing power” (*id.* at 4: 8-9). Numerous anionic, nonionic, and amphoteric surfactants are disclosed as suitable (*id.* at 5-9). Amphoteric starches having the structures shown in Formulas I-IV were known in the art (*id.* at 9: 16 to 11: 10).

The compositions can also comprise a cationic polymer (*id.* at 12: 3) such as Jaguar C 17 (*id.* at 17: 10). The compositions can also comprise a silicone (*id.* at 26: 19-20) such as dimethiconol (*id.* at 29: 5-6) or dimethicone copolyol (*id.* at 32: 2-4).

Finally, the compositions can be free of fatty acid soaps (*id.* at 3: 4-6). The Specification defines “fatty acid soap” to mean “salts of alkali metals, salts of alkaline-earth metals, fatty amines and C₁₀-C₁₈ fatty acids” (*id.* at 3: 17-18).

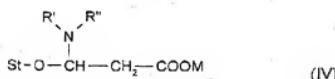
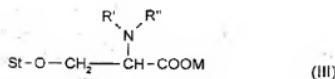
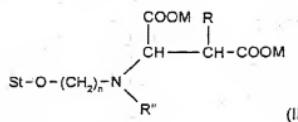
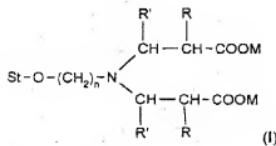
DISCUSSION

1. CLAIMS

Claims 1-10, 12, 14, 16-18, 20-22, and 30-34 are on appeal. Claims 13, 15, 23-29, and 37-44 are also pending but have been withdrawn from consideration by the Examiner (Office action mailed Sept. 17, 2003, p. 1).

The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 is the only independent claim on appeal and reads as follows:

1. A cosmetic composition comprising, in a cosmetically acceptable aqueous medium, a washing base and at least one amphoteric starch chosen from the compounds of formulae (I) to (IV):



wherein:

-St-O is a starch moiety;

-R, which may be identical or different, are each chosen from a hydrogen atom and a methyl group;

-R', which may be identical or different, are each chosen from a hydrogen atom, a methyl group, and a -COOH group;

-n is chosen from integers ranging from 2 to 3;

-M, which may be identical or different, are each chosen from a hydrogen atom, an alkali metal, an alkaline-earth metal, NH₄, quaternary ammonium compounds, and organic amines; and

R", which may be identical or different, are each chosen from a hydrogen atom and alkyl groups having from 1 to 18 carbon atoms,

wherein said composition is a detergent and conditioning composition further comprising at least one cationic polymer and at least one silicone, and wherein said composition is free of fatty acid soaps.

2. OBVIOUSNESS

Claims 1-10, 12, 14, 16-18, 20-22, and 30-34 stand rejected under 35 U.S.C. § 103 as obvious in view of Sweger,¹ Babenko,² Murray,³ and Saint Leger.⁴ We agree with the Examiner that the cited references support a *prima facie* case of obviousness with respect to claim 1. (Saint Leger, in fact, does not appear to be necessary to meet the limitations of claim 1, and we will not discuss it further.)

Murray teaches a conditioning shampoo composition (Murray, abstract). Murray's composition comprises

- a cosmetically acceptable aqueous medium (water; *id.* at 1: 49),
- anionic surfactant and optionally nonionic or amphoteric surfactants (*id.* at 1: 48, 4: 66-67),
- a cationic polymer (*id.* at 1: 57-59) such as Jaguar C17 (*id.* at 4: 25-30), and

¹ Sweger et al., U.S. Patent 5,482,704, issued Jan. 9, 1996.

² Babenko, U.S. Patent 6,277,893 B1, issued Aug. 21, 2001.

³ Murray, U.S. Patent 5,720,964, issued Feb. 24, 1998.

⁴ Saint Leger, U.S. Patent 5,919,438, issued July 6, 1999.

- a silicone (dimethiconol; *id.* at 1: 50-56, 5: 55-62).

Murray discloses exemplary compositions that also contain “Carbopol 980” (*id.* at 6: 7-30, Examples 2 and 3). Murray’s compositions do not comprise the amphoteric starches of Formulas I-IV.

Sweger teaches hair care compositions comprising the amphoteric starches of Formulas I and II (Sweger, abstract, 1: 41-67). Sweger teaches that the amphoteric starches are thickeners and emulsion stabilizers (*id.* at 4: 29-33). Sweger compares lotion compositions containing an amphoteric starch (CEPA potato starch) with a control containing “thickener (Carbopol)” and secondary emulsifiers (*id.* at 8: 1-10; “Control 2” contained Carbopol 940 and the secondary emulsifiers “Ceteth 20” and “Glyceryl stearate SE”). Sweger discloses that experimental sample A, which contained amphoteric starch but no Carbopol or secondary emulsifiers, “is actually superior to the Carbopol standard (Control 2)” in maintaining viscosity of the lotion composition over time (*id.* at 8: 48 to 9: 5).

Babenko teaches the same amphoteric starches disclosed by Sweger (Babenko, 1: 60 to 2: 19) as useful in combination with dimethicone copolyol (*id.* at 2: 20-38) as an emulsifier for oil-in-water emulsions (*id.* at 2: 50-58), which are “widely used in cosmetic and dermatol[o]gical compositions or applications, particularly skin, hair and body care compositions” (*id.* at 1: 24-26). Babenko expressly suggests using the disclosed emulsion in shampoos (*id.* at 5: 20-23).

Based on these teachings, we agree with the Examiner that the composition of instant claim 1 would have been obvious to a person of ordinary skill in the art. Murray discloses a conditioning shampoo (e.g., the Example #2 composition) that comprises all the ingredients of claim 1’s

composition except for the amphoteric starch: cosmetically acceptable medium (water), washing base (the anionic surfactant sodium lauryl ether sulphate), cationic polymer (Jaguar C17), and silicone (50% silicone emulsion polymer). (Murray 6: 6-30.)

Sweger and Babenko disclose the amphoteric starches of Formulas I and II. Sweger teaches that they are useful as thickeners and emulsifiers in hair care compositions, and Babenko teaches that an oil-in-water emulsion comprising the amphoteric starches and a silicone is useful in shampoos. Finally, Sweger teaches that the amphoteric starches are superior to Carbopol in providing a stable, thickened composition.

Based on the teachings of the cited references, a person of ordinary skill in the art would have considered it obvious to substitute the amphoteric starch disclosed by Sweger and Babenko for the Carbopol used in Murray's Example #2 composition, because of the superior performance taught by Sweger. The resulting composition does not contain fatty acid soaps, and meets all the limitations of instant claim 1.

Appellants argue that the only detergent-containing composition disclosed by Sweger also "contains stearic acid and triethanolamine, the combination of which forms fatty acid soap" (App. Br. 14). Appellants conclude that the references would not have suggested a composition containing the ingredients recited in claim 1 and free of fatty acid soaps (*id.* at 15).

This argument is not persuasive, for two reasons. First, Appellants have presented no evidence to show that the components in Sweger's Example VI composition (Sweger 11: 10-45) will form a compound within

the Specification's definition of "fatty acid soap" when mixed under the conditions disclosed by Sweger. Attorney argument does not take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Second, Sweger's Example VI shows a shaving cream composition, while Sweger and Babenko both suggest including amphoteric starches in hair care compositions such as the shampoo disclosed by Murray. Murray's exemplary conditioning shampoo compositions do not contain fatty acid soaps, and Murray provides no basis for those skilled in the art to conclude that fatty acid soaps are a necessary, or even desirable, component of conditioning shampoos. Considered as a whole, the references would have suggested the composition of claim 1, including the limitation that the composition be free of fatty acid soaps.

We have considered the other arguments made in the Appeal Brief and Reply Brief, but they are not particularly relevant to the rationale we rely on above.

SUMMARY

We affirm the rejection of claim 1 as obvious in view of Sweger, Babenko, Murray, and Saint Leger. Claims 2-10, 12, 14, 16-18, 20-22, and 30-34 fall with claim 1. Because our rationale differs from that of the Examiner, however, we designate our affirmance a new ground of rejection in order to give Appellants a fair opportunity to respond.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

37 C.F.R. § 41.50(b)

Ssc:

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413